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**LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP**  
600 South Avenue West • Westfield, NJ 07090  
Tel: 908 654 5000 • Fax: 908 654 7866

OFFICIAL

**Faxtransmittal**

| To:  | Fax Number   | Voice Number |
|--|--------------|--------------|
| United States Patent and<br>Trademark Office<br>Attn: Image File Wrapper | 703-872-9306 |              |

From: Harvey L. Cohen, Esq.

Date: May 10, 2004 No. Pages: 10 (not including transmittal page) Original Mailed: No

Client/Matter No: SCHERI/337

• MESSAGE: RE: Application No. 09/909,062

Please enter the attached documents and fax back confirmation of receipt of same.

cc: Information copy to:  
John Gillon, Esq. (Office of Petitions)  
Fax No. 703-305-4257

NOTICE: The information contained herein is intended only for the addressee identified above. It may be or may include material that is confidential, attorney-client privileged, attorney work product, copyrighted, and/or inside information. If you are not the intended recipient, or a person responsible for delivering this message to the intended recipient, you are hereby notified that the unauthorized use, disclosure, distribution or copying is strictly prohibited and may be in violation of court order or otherwise unlawful. If you have received this transmission in error, please immediately notify us at 908 654 5000 (collect, if necessary) and return this document to us by mail.

492526\_1.DOC

I hereby certify that this paper is being transmitted by facsimile to the United States Patent and Trademark Office on May 10, 2004.

Signature:   
(Harvey L. Cohen)

To: United States Patent and Trademark Office  
Attn: Image File Wrapper  
Fax No.: (703) 873-9306  
No. of Pages: 10

Docket No.: SCHERING 3.0-120  
(PATENT)

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MAY 10 2004

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Saksena et al.

Application No.: 09/909,062

Confirmation No.: 9813

Filed: July 19, 2001

Art Unit: 1654

For: NOVEL PEPTIDES AS NS3-SERINE  
PROTEASE INHIBITORS OF HEPATITIS C  
VIRUS

Examiner: M. A. Audet

**PETITION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants petition the Director under 37 CFR 1.181(a)(3) to revive the above-identified patent application in view of the following facts:

1. As shown on the attached copies of the "Updated Filing Receipt" and first page of the Office Action mailed March 26, 2003, the original correspondence address for the above-identified application was Schering-Plough Corporation located in Kenilworth, New Jersey.

2. As shown by the File History, a copy of which is enclosed herein for reference, an Associate Power of Attorney and Correspondence Address Change was entered on October 9, 2003 (copy enclosed). The new correspondence address was changed to "Customer Number 00530", which corresponds to Lerner, David, Littenberg, Krumholz & Mentlik, LLP, 600 South Avenue West, Westfield, New Jersey 07090.

Application No.: 09/909,062

Docket No.: SCHERING 3.0-120

3. On December 10, 2003, following correspondence of record and a brief telephone conversation between the undersigned and Examiner Audet, the undersigned received a telephone call from Examiner Audet in which the Examiner stated that a Notice of Allowance would issue shortly.

4. In the course of a routine status check on May 6, 2004 of the application via the PAIR system by support staff of the undersigned's firm, it was learned that a Notice of Allowance was mailed on December 18, 2003.

5. After a thorough review of the application file and other internal records and docket computer database of the firm, as well as a similar review of the records of Schering-Plough, it was determined that the Notice of Allowance had not been received.

6. On May 6, 2004, a call was placed to Examiner Audet regarding the above matter, and on May 7th the Examiner called the undersigned. At that time it was learned that:

A. The Associate Power of Attorney had been correctly entered on the records of the Office, but the Notice of Allowance and Fee(s) Due had not been mailed to Customer Number 00530; and

B. The Notice of Allowance and Fee(s) Due had instead been mailed to an unrelated party, Ernest D. Buff, Esq. of Morristown, New Jersey. A copy of the cover page of that notice, provided on May 7, 2004 by facsimile by Examiner Audet, is attached hereto.

7. As it was impossible for Applicants to respond to the improperly mailed Notice, Applicants hereby petition the Examiner as follows:

A. to revive the subject application without the payment of a fee therefore;

B. to promptly issue a properly captioned and addressed Notice of Allowance and Fee(s) Due to the undersigned; and

Application No.: 09/909,062

Docket No.: SCHERING 3.0-120

C. to make of record that Applicants are entitled to a credit for the time lost between the first date of mailing of said Notice, December 18, 2003, and the new mailing date under 7.B. above pursuant to 35 U.S.C. 154(b).

If for any reason the Petitions attorney does not believe that the Petition under 37 CFR 1.181(a)(3) can be granted, it is respectfully requested that he or she telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections that he or she might have.

If there are any additional charges in connection with the Petition and response, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: May 10, 2004

Respectfully submitted,

By   
Harvey L. Cohen  
Registration No.: 28,365  
LERNER, DAVID, LITTBENBERG,  
KRUMHOLZ & MENTLIK, LLP  
600 South Avenue West  
Westfield, New Jersey 07090  
(908) 654-5000  
Attorney for Applicant

492499\_1.DOC



## UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
 UNITED STATES PATENT AND TRADEMARK OFFICE  
 Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

| APPLICATION NUMBER | FILING DATE | GRP ART UNIT | FIL. FEE REC'D | ATTY.DOCKET.NO | DRAWINGS | TOT CLAIMS | IND CLAIMS |
|--------------------|-------------|--------------|----------------|----------------|----------|------------|------------|
| 09/909,062         | 07/19/2001  | 1646         | 1892           | IN01157K       |          | 54         | 4          |

CONFIRMATION NO. 9813

UPDATED FILING RECEIPT

  
 "0C00000000970725"

24265  
 SCHERING-PLough CORPORATION  
 PATENT DEPARTMENT (K-6-1, 1990)  
 2000 GALLOPING HILL ROAD  
 KENILWORTH, NJ 07033-0530

Date Mailed: 10/25/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

Anil K. Saksena, Upper Montclair, NJ;  
 Viyyoor Moopill Girijsvallebhan, Parsippany, NJ;  
 Raymond G. Lovey, West Caldwell, NJ;  
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 Russell E. Pike, Stanhope, NJ;  
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 Yi-Tsung Liu, Morris Township, NJ;  
 Ashok Arasappan, Bridgewater, NJ;  
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 Patrick A. Pinto, Morris Plains, NJ;  
 F. George Njoroge, Warren, NJ;  
 Ashit K. Ganguly, Upper Mountclair, NJ;  
 Terence K. Brunck, Santa Fe, NM;  
 Scott Jeffrey Kemp, San Diego, CA;  
 Odile Esther Levy, San Diego, CA;  
 Marguerita Lim-Wilby, La Jolla, CA;

## Domestic Priority data as claimed by applicant

THIS APPLN CLAIMS BENEFIT OF 60/220,109 07/21/2000

## Foreign Applications

If Required, Foreign Filing License Granted 08/29/2001

**Projected Publication Date:** 01/31/2002

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Novel peptides as NS3-serine protease inhibitors of hepatitis C virus

**Preliminary Class**

530

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**LICENSE FOR FOREIGN FILING UNDER**  
**Title 35, United States Code, Section 184**  
**Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

AMN



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Commissioner of Patents and Trademarks  
 Washington, D.C. 20531  
[www.uspto.gov](http://www.uspto.gov)

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/909,062      | 07/19/2001  | Antti K. Saksena     | IND1157K            | 9813             |

24263 7590 03/26/2003  
 SCHERING-PLough CORPORATION  
 PATENT DEPARTMENT (K-6-1, 1990)  
 2000 GALLOPING HILL ROAD  
 KENILWORTH, NJ 07033-0530

*Done  
6/26/03*

|                |              |
|----------------|--------------|
| EXAMINER       |              |
| AUDET, MAURY A |              |
| ART UNIT       | PAPER NUMBER |
| 1654           |              |

DATE MAILED: 03/26/2003

**PATENT DEPARTMENT  
RECEIVED**

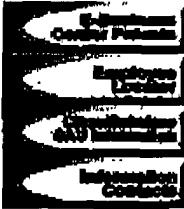
APR 01 2003

Computer Input ✓  
 Date: 4/3/2003  
 PA: *PSK* mgd/b  
 Atty: *PSK*  
 FILE  CHECK

*Response due  
June 24, 2003*



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|                         |   |                            |   |
|-------------------------|---|----------------------------|---|
| Application Number:     | 09/909,062  | Customer Number:           | -   |
| Filing or 371(c) Date:  | 07-19-2001  | Status:                    | Notice of Allowance Mailed – Application Received In Office of Publications |
| Application Type:       | Utility   | Status Date:               | 02-11-2004  |
| Examiner Name:          | AUDET, MAURY A  | Location:                  | ELECTRONIC  |
| Group Art Unit:         | 1654  | Location Date:             | -   |
| Confirmation Number:    | 9813  | Earliest Publication No:   | US 2003-0036501 A1  |
| Attorney Docket Number: | IN01157K  | Earliest Publication Date: | 02-20-2003  |
| Class/ Sub-Class:       | 435/006   | Patent Number:             | -   |
| First Named Inventor:   | Anil Saksena, Upper Montclair, NJ                                     | Issue Date of Patent:      | -   |
| Title Of Invention:     | NOVEL PEPTIDES AS NS3-SERINE PROTEASE INHIBITORS OF HEPATITIS C VIRUS |                            |   |

## Select Search Option

Assignments  
 Continuity Data  
 Patent Term Adjustment History  
 Published Documents

**File History**

| Date       | Contents Description                            |
|------------|---|
| 04-23-2004 | Receipt Into Pubs                               |
| 02-11-2004 | Workflow - File Sent to Contractor              |
| 02-11-2004 | Receipt Into Pubs                               |
| 12-18-2003 | Mail Notice of Allowance                        |
| 12-12-2003 | Issue Revision Completed                        |
| 12-12-2003 | Notice of Allowance Data Verification Completed |
| 12-12-2003 | Notice of Allowability                          |
| 10-09-2003 | Correspondence Address Change                   |
| 10-09-2003 | Correspondence Address Change                   |
| 09-29-2003 | Information Disclosure Statement (IDS) Filed    |

|            |   |
|------------|---|
| 10-07-2003 | Date Forwarded to Examiner                                  |
| 09-29-2003 | Response after Non-Final Action                             |
| 09-29-2003 | Request for Extension of Time - Granted                     |
| 03-26-2003 | Mail Non-Final Rejection                                    |
| 03-24-2003 | Non-Final Rejection   |
| 03-03-2003 | Case Docketed to Examiner in GAU                            |
| 02-27-2003 | Date Forwarded to Examiner                                  |
| 02-13-2003 | Response after Non-Final Action                             |
| 02-13-2003 | Request for Extension of Time - Granted                     |
| 02-21-2003 | CRF Is Good Technically / Entered Into Database             |
| 12-19-2002 | Mail Miscellaneous Communication to Applicant               |
| 12-19-2002 | Miscellaneous Action with SSP                               |
| 10-28-2002 | Date Forwarded to Examiner                                  |
| 10-21-2002 | Response to Election / Restriction Filed                    |
| 10-02-2002 | Mail Restriction Requirement                                |
| 10-01-2002 | Requirement for Restriction / Election                      |
| 07-18-2002 | Information Disclosure Statement (IDS) Filed                |
| 08-08-2002 | Case Docketed to Examiner in GAU                            |
| 01-03-2002 | Information Disclosure Statement (IDS) Filed                |
| 05-07-2002 | Case Docketed to Examiner in GAU                            |
| 01-03-2002 | Information Disclosure Statement (IDS) Filed                |
| 10-25-2001 | Application Dispatched from OIPE                            |
| 10-25-2001 | Application Is Now Complete                                 |
| 09-06-2001 | Notice Mailed--Application Incomplete--Filing Date Assigned |
| 08-29-2001 | Correspondence Address Change                               |
| 07-30-2001 | IFW Scan & PACR Auto Security Review                        |
| 07-19-2001 | Initial Exam Team nn  |

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## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Admiral Jacob F.amerson, III  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Washington, D.C. 20231-1450

## NOTICE OF ALLOWANCE AND FEE(S) DUE

2500 15102004

ERNEST D. BUFF, ESQ.  
ERNEST D. BUFF & ASSOCIATION  
245 SOUTH STREET  
MORRISTOWN, NJ 07960

|                |              |
|----------------|--------------|
| EXAMINER       |              |
| AUDIT, MAURY A |              |
| ART UNIT       | PAPER NUMBER |
| 1664           |              |

DATE MAILED: 05/10/2004

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/908,662      | 07/18/2001  | Asli K. Suleiman     | IND1157K            | 9813             |

TITLE OF INVENTION: NOVEL PEPTIDES AS NE3-SERINE PROTEASE INHIBITORS OF HEPATITIS C VIRUS

| APPLN. TYPE    | SMALL ENTITY | ISSUE FEE* | PUBLICATION FEE | TOTAL FEE(S) DUE | DATE DUE   |
|----------------|--------------|------------|-----------------|------------------|------------|
| nonprovisional | NO           | \$1320     | \$300           | \$1620           | 05/10/2004 |

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

## HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

Applicant claims SMALL ENTITY status.  
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are changing the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1986 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

Page 1 of 3

PTOL-85 (Rev. 11/03) Approved for use through 04/30/2004.

Docket No.: SCHERING 3.0-120  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Saksena et al.

Application No.: 09/909,062

Group Art Unit: 1654

Filed: July 19, 2001

Examiner: M. Audet

For: NOVEL PEPTIDES AS NS3-SERINE  
PROTEASE INHIBITORS OF HEPATITIS C  
VIRUS

ASSOCIATE POWER OF ATTORNEY

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Please recognize as Associate Practitioners in this case all practitioners associated with Customer No. 00530 to prosecute this application and transact all business in the U.S. Patent and Trademark Office connected herewith.

Please change the correspondence address to Customer Number 00530.

Dated: June 26, 2003

Respectfully submitted,

By   
Palaiyur S. Kalyanaraman  
Registration No.: 34,634  
Schering-Plough Corporation  
2000 Galloping Hill Road  
K-6-1 1990  
Kenilworth, NJ 07033-0530  
(908) 298-5068  
Attorney for Applicant

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